

PATENT

Paper No.

File: Skuba-P1-03

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

---

Inventor : SKUBA, Jerome  
Serial No. : 10/730,325  
Filed : 8 December 2003  
For : IMPROVED METHOD OF PROPAGATION AND  
PRODUCT PRODUCED THEREBY  
Group Art Unit : 3644  
Examiner : PALO, Francis

---

MS: Appeal  
Honorable Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 2231301459

**APPEAL BRIEF IN REINSTATED APPEAL**

S I R :

Pursuant to the provisions set forth in MPEP 1204.01, Applicant reinstates the appeal. Accordingly, this Appeal Brief is in response to the Final Rejection by the Examiner dated 11/14/08, finally rejecting at least claims 1-21. Claims 22-24, pending in this application, have been acknowledged in the Final Rejection and have not been rejected; this appeal is occasioned because claims have been twice rejected.

The Office Action dated 12/12/07 reopening prosecution does not show the approval by the Supervising Primary Examiner as required by MPEP Sec. 1207.04. Regardless of whether the Examiner improperly reopened prosecution, Applicant is reinstating the appeal as provided by MPEP Sec. 1204.01.

The fees due for the Notice of Appeal and the Appeal Brief paid in the previous appeal

are to be applied to the reinstated appeal because the Board did not issue a final decision in the previous appeal. Any difference in the fees paid and the fees presently in force should be charged to Deposit Account No. 50-0235, along with any fee for any Extension of Time for filing of this appeal and Brief or for further prosecution. A Request for Oral Hearing will be filed in response to the Examiner's Answer.

**I. Real Party In Interest**

The real party in interest is the inventor, Jerome Skuba.

**II. Related Appeals and Interferences**

Appeals in each of the predecessor applications resulted in patents without any decision by the Board (See U.S. Patent Nos. 6,336,291 and 6,658,790), and there are no related appeals or interferences believed to be related.

**III. Status of Claims**

Claims 1-21 have been rejected under 35 U.S.C. 102(a). Claims 22-24 have not been rejected or allowed.

**IV. Status of Amendments Filed Subsequent to Final Rejection**

No Amendments have been filed since the Final Rejection was issued.

**V. Summary of the Claimed Subject Matter**

The claimed subject matter is believed to be summarized well in claim 1, which is as follows: A method of forming a garden, the method including: forming a design for a garden; implementing the design by forming a piece corresponding to a portion of the design, the piece including at least one member of the group consisting of forbs, a shrub, a tree, annuals, flowering plants, a bush, wildflowers, grasses, a space for a shrub, a space for a tree, a space for annuals, a space for layers of flowering plants, a space for a bush, a space for wildflowers, a

space for grasses, a space for a walkway, and a space for a garden accouterment, by growing roots in the piece at at least one grower location; transporting the piece to a user's garden location; and installing the piece, so that the roots can knit essentially unimpeded from the piece into earth below the piece at the user's garden location, in accordance with the design.

It is also believed that the claimed subject matter as to claim 21 is best summarized by the claim itself: A method of forming a corporate logo garden, the method including: forming a design for a garden comprised of a corporate logo; growing the corporate logo, in accordance with the design, including at least one member of the group consisting of a forb, a shrub, a tree, an annual, a flowering plant, a bush, a wildflower, and grass, at a grower location; transporting the corporate logo to a garden site; and installing the corporate logo at the garden site to produce the garden having the corporate logo design.

More particularly, please see the chart below:

**Claims**

**Representative Support**

1. A method of forming a garden, the method including:

forming a design for a garden;

implementing the design by forming a piece corresponding to a portion of the design, the piece including at least one member of the group consisting of forbs, a shrub, a tree, annuals, flowering plants, a bush, wildflowers, grasses, a space for a shrub, a space for a tree, a space for annuals, a space for layers of flowering plants, a space for a bush, a space for wildflowers, a space for grasses, a space for a walkway, and a space for a garden accouterment, by growing roots in the piece at at least one grower location;

transporting the piece to a user's garden location; and

installing the piece, so that the roots can knit essentially unimpeded from the piece into earth below the piece at the user's garden location, in accordance with the design.

FIG. 6 is an illustration of a design...

...commercially producing a garden design... Pg. 8, para 4 Lns. 11-12

...combination of the articles, that is, including a second article...forbs, grass, at least one shrub, at least one tree, perennials, annuals, or any combination thereof--even with spacing for such garden accouterments as a walkway, water garden, bird bath, fountain, furniture, or other commonly encountered garden apparatus or manufacture. Page 10, para 1, Lns. 6-18

...transporting the design from a grower to a user's site... Page 8, para 4, line 13

2. A method of forming a garden,  
the method including:

forming a design for a garden;

commercially producing a garden design...

Pg. 8, para 4 Lns. 11-12

forming pieces corresponding to  
portions of the design by growing mats of roots  
of respectively different kinds of plants, in  
accordance with the design, at at least one  
grower location;

propagating wild flowers in sod mats... such  
that roots of seedlings from said seeds  
intermesh with the fabric forming a sod mat;  
Page 9, para. 2, Ins. 9-13;

harvesting the mats;

...for easier propagation and harvesting  
purposes. Page 18, para. 2, ln. 13;

transporting the mats to a user's  
garden location; and

...wherein the composition...do not fall  
apart during... transporting, Page 6, para.  
5, ln. 17; ... transporting the design from a  
grower to a user's site, Page 6, para. 5, ln.  
17; ... plant crowns and roots are allowed  
to knit with the earth... Page 9, line 5.

installing the mats at the user's garden location  
so that the roots are able to knit essentially  
unimpeded from the mats into earth below the  
mats to form the garden, according to the  
design.

3. The method of claim 2, wherein the design is implemented with at least one of the pieces including at least one member of the group consisting of forbs, a shrub, a tree, annuals, flowering plants, a bush, wildflowers, grasses, a crop, a space for a shrub, a space for a tree, a space for annuals, a space for flowering plants, a space for a bush, a space for wildflowers, a space for grasses, a space for a walkway, and a space for a garden accouterment, in accordance with the design.

4. The method of claim 3, further including a second member of the group, in accordance with the design.

5. The method of claim 3, further including a third member of the group, in accordance with the design.

...including a second article...forbs, grass, at least one shrub, at least one tree, perennials, annuals, or any combination thereof--even with spacing for such garden accouterments as a walkway, water garden, bird bath, fountain, furniture, or other commonly encountered garden apparatus or manufacture. Page 10, para 2, Ins. 8-18

...there is a combination of the articles, that is, including a second article, ... Page 10, para. 2, Ins. 7-8.

... there is a combination of the articles, ...: a top net; a bottom net made of a material that is pervious to moisture; a mat intermediate the top net and the bottom net; a three-dimensional net intermediate the top net and the mat...Page 10, para. 2, Ins 7-10

6. The method of claim 3, wherein the mats differ by at least one kind of plant that is a member of the group, in accordance with the design.

...wherein the articles are installed adjacent each other and include a different kind of plants. Page 10, para. 2, Ins. 13-14

7. The method of claim 3, wherein the mats differ by at least two kinds of plants that are members of the group, in accordance with the design.

...wherein the plant roots include roots of prairie wildflowers ...forbs, grass, at least one shrub, at least one tree, perennials, annuals, or any combination thereof...Page 10, para. 2, Ins. 15-17.

8. The method of claim 3, wherein the mats differ by at least three kinds of plants that are members of the group, in accordance with the design.

...wherein the plant roots include roots of prairie wildflowers ...forbs, grass, at least one shrub, at least one tree, perennials, annuals, or any combination thereof...Page 10, para. 2, Ins. 15-17.

9. The method of claim 3, wherein the mats differ by at least four kinds of plants that are members of the group, in accordance with the design.

...wherein the plant roots include roots of prairie wildflowers ...forbs, grass, at least one shrub, at least one tree, perennials, annuals, or any combination thereof...Page 10, para. 2, Ins. 15-17.

10. The method of claim 3, wherein the mats differ by at least five kinds of plants that are members of the group, in accordance with the design.

...wherein the plant roots include roots of prairie wildflowers ...forbs, grass, at least one shrub, at least one tree, perennials, annuals, or any combination thereof...Page 10, para. 2, Ins. 15-17.

11. The method of claim 3, wherein the mats differ by at least six kinds of plants that are members of the group, in accordance with the design.

...wherein the plant roots include roots of prairie wildflowers ...forbs, grass, at least one shrub, at least one tree, perennials, annuals, or any combination thereof...Page 10, para. 2, Ins. 15-17.

12. The method of claim 3, wherein the mats differ by at least seven kinds of plants that are members of the group, in accordance with the design.

...wherein the plant roots include roots of prairie wildflowers ...forbs, grass, at least one shrub, at least one tree, perennials, annuals, or any combination thereof...Page 10, para. 2, Ins. 15-17.

13. The method of claim 3, wherein the mats differ by at least eight kinds of plants that are members of the group, in accordance with the design.

...wherein the plant roots include roots of prairie wildflowers ...forbs, grass, at least one shrub, at least one tree, perennials, annuals, or any combination thereof...Page 10, para. 2, Ins. 15-17.

14. The method of claim 6, further including lawn on a portion of at least one of the mats.

...a formal garden, complete with a lawn ...  
Page 19, para. 2, In. 8



15. The method of claim 7, further including lawn on a portion of at least one of the mats. ...a formal garden, complete with a lawn...Page 19, para. 2, ln. 8
16. The method of claim 2, wherein the forming the design includes forming a design of a corporate logo. ...garden design, such as, a corporate logo... Page 8, para. 4, lns 11-12;  
...here represented by a corporate logo...Page 11, para. 6, ln 12;  
...create a seed pattern to construct a design such as a corporate logo...Page 20, para. 2, ln. 3
17. The method of claim 1, wherein the forming the design includes forming a design of a corporate logo. ...garden design, such as, a corporate logo... Page 8, para. 4, lns 11-12;  
...here represented by a corporate logo...Page 11, para. 6, ln 12;  
...create a seed pattern to construct a design such as a corporate logo...Page 20, para. 2, ln. 3;

18. The method of claim 1, wherein the forming the piece is carried out so as to include a second member of the group, in accordance with the design.

...there is a combination of the articles, that is, including a second article, ... Page 10, para. 2, Ins. 7-8.

19. The method of claim 1, wherein the forming the piece is carried out so as to include a third member of the group, in accordance with the design.

...  
... wherein the plant roots include roots of prairie wildflowers...forbs, grass, at least one shrub, at least one tree, perennials, annuals, or any combination thereof...Page 10, para. 2, Ins. 15-17

20. The method of claim 1, further including forming a second piece corresponding to a second portion of the design, the second piece differing from the first piece by at least one kind of plant that is a member of the group, in accordance with the design;

growing the second piece, in accordance with the design;

transporting the second piece to the user's garden location; and

installing the second piece at the user's garden location, in accordance with the design.

a combination of the articles, that is, including a second article, the second including...wherein the articles are installed adjacent each other and include a different kind of plants...Page 10, para. 2, Ins. 7-14

there is a combination...including a second article, the second... including...a growing medium...plant roots in the growing medium; and wherein the bottom net is sufficiently pervious to permit...root contact with earth below the bottom net...Page 10, para. 2, Ins. 7-13;

Such articles can be ...transported to a site of installation...Page 10, para. 2, Ins. 14-15  
Page 10, para. 3, Ins. 14-15

an entire garden can be ... installed according to plan at a user's location...Page 19, para. 2, Ins. 16-18

21. A method of forming a corporate logo garden, the method including:  
  
forming a design for a garden comprised of a corporate logo;  
  
growing the corporate logo, in accordance with the design, including at least one member of the group consisting of a forb, a shrub, a tree, an annual, a flowering plant, a bush, a wildflower, and grass, at a grower location;

transporting the corporate logo to a garden site; and

installing the corporate logo at the garden site to produce the garden having the corporate logo design.

22. The method of claim 1, wherein the forming comprises locating a biodegradable matrix within the piece.

23. The method of claim 2, wherein the growing comprises locating a biodegradable matrix within the piece.

...garden design, such as, a corporate logo... Page 8, para. 4, lns 11-12;

...here represented by a corporate logo...Page 11, para. 6, ln 12;

...create a seed pattern to construct a design such as a corporate logo...Page 20, para. 2, ln. 3

...transporting, and then timely installing the logo on site in one quick and convenient installation...Page 20, para. 1, lns. 5-6

...composition and article of manufacture include at least one biodegradable base sheet...Page 7, para. 1, ln. 3

... formed on a sheet of a porous, preferably biodegradable... material;

Page 8, para. 7, Ins. 21-22;

...is formed on a sheet of a porous,  
preferably biodegradable textile  
material...Page 9, para.2, ln. 15;

24. The method of claim 3, wherein the  
growing comprises growing the corporate logo  
in a biodegradable matrix.

...bottom net...can be biodegradable, which  
facilitates making...structure 2 as  
including...one moisture-permeable bottom  
net...preferably reasonably biodegradable.  
Page 13, para. 3, Ins. 12-14; ...as made  
completely of biodegradable plastic  
material...Page 13, para. 3, Ins. 16-17.

**VI. Grouping of Claims for Each Ground of Rejection Which Appellant Contests**

The claims are grouped as follows:

- Group I.        Claims 1, 18-20
- Group II.       Claim 17
- Group III.      Claims 2-15
- Group IV.       Claim 16
- Group V.        Claim 21
- Group VI.       Claim 22
- Group VII.      Claim 23
- Group VIII.     Claim 24

**A.     § 102**

1.        Has the Examiner made a prima facie showing that claim of Group I are unpatentable pursuant to 35 U.S.C. § 102(e) based on JP 10313690A (Kawamoto)?
2.        Has the Examiner made a prima facie showing that claim of Group II are unpatentable pursuant to 35 U.S.C. § 102(e) based on JP 10313690A (Kawamoto)?
3.        Has the Examiner made a prima facie showing that claim of Group III are unpatentable pursuant to 35 U.S.C. § 102(e) based on JP 10313690A (Kawamoto)?
4.        Has the Examiner made a prima facie showing that claim of Group IV are unpatentable pursuant to 35 U.S.C. § 102(e) based on JP 10313690A (Kawamoto)?
5.        Has the Examiner made a prima facie showing that claim of Group V are unpatentable pursuant to 35 U.S.C. § 102(e) based on JP 10313690A (Kawamoto)?

The Examiner appears to have examined and considered claims 22-24 as noted in the Final Rejection of 11/14/08 at page 4. These claims are not listed on the Office Action Summary

page, so the Examiner either made an error on the Summary page or neglected to indicate whether the claims are allowed or rejected. However, clearly appeal guidance is needed where the Examiner rejects claims pursuant to Sec. 102, concedes that cited art devices “are incapable” of meeting the claim requirements, and after an appeal, reopens prosecution and maintains the rejection. Thus, to advance prosecution with appellate guidance, the claims that the Examiner apparently neglected to examine are set forth herein to ensure that they are not altogether omitted from the application. As these are dependent claims, a reversal of the rejection of the independent claims would be equally applicable to a reversal on the dependent claims.

## **VII. Argument**

### **A. Overview**

This appeal involves 35 U.S.C. Sec. 102, the basis for the rejection of each of claims 1-21 in the Final Rejection.

In the Final Rejection, the Examiner contends that each of claims 1-21 is anticipated by Kawamoto.

In a nutshell, as discussed in greater detail below, Applicant’s claims 1-20 are directed to mats or pieces applied directly to the earth. The cited art (Kawamoto) is directed to container gardening “on a rooftop and balcony of a building or inside lot.” Thus, the cited art is not the same as the claimed subject matter, especially as to whether the roots can knit essentially unimpeded... into the earth below.

The Office Action of 03/08/07 (Page 6) concedes that “the manufactured multiple standardized units of Kawamoto are incapable of knitting with the earth below due to their containment means”. As pointed out in Applicant’s pre-appeal brief review request, there cannot be anticipation where the prior art device is incapable of meeting the requirements of

the claims.

Responsive to a pre-appeal brief review request, the Examiner reopened prosecution to attempt to retrench from that which he had conceded by stating in the Final Rejection of 11/14/08, at page 3:

“the statement that the applicant that the examiner ‘concedes’ is no longer a valid argument, and the examiner has put forth that the drainage holes (25c) of the Kawamoto ‘690 piece are capable of allowing roots by way of the drainage holes to find their way to and thus knit essentially unimpeded into the earth below....”

This statement reflects Examiner imagination rather than a teaching by an anticipatory reference. More so, the Examiner’s attempt to retrench overlooks the fact that the Kawamoto containers are located on a rooftop and balcony of a building or inside lot, and thus the Examiner’s retrenching would have to have the roots making it through drainage holes and out of the on a rooftop and balcony of a building or inside lot; all of this and still be in accordance with the design so as to meet Applicant’s claim requirements. The Examiner’s retrenching would also have the roots do so without plugging the holes (so as to contradict the very purpose of *drainage* holes) or plug the drainage holes such that trapped moisture would kill the plant(s), while the roots are protruding off the rooftop or balcony or lot, so as to be essentially unimpeded. Yet further, Kawamoto mentions that “soil” is part of the problem to be solved by his invention and instead uses “artificial resin”, which again contradicts Applicant’s claimed roots can knit essentially unimpeded... into the earth below. More so, Kawamoto places underneath his containers “a water-penetrating type of sheet” further impeding the roots finding their way into the earth below. Yet further, the Examiner adds a bit of local color to what is alleged to be an anticipatory reference:

“It is well known to most everyone ever exposed to a plant in a container having drainage holes, roots do find their way to and through said holes and where the container is on the ground, those escaped roots grow into the ground below the



container.”

(Final Rejection of 11/14/08 at Page 7) The Examiner’s addition also shows insufficiency of Kawamoto as an anticipatory reference. The addition also is premised upon the Examiner’s assumption that there is ground proximately below the container of Kawamoto. Actually, Kawamoto teaches to the contrary.

With all due respect, the Examiner’s attempted retrenching is rather far fetched, and in a nutshell, Kawamoto does not meet the requirements of an anticipatory reference. There is no teaching in Kawamoto of installing the piece, so that the roots can knit essentially unimpeded from the piece into the earth below the piece at the user’s location, in accordance with the design as per Groups I and II, and no teaching in Kawamoto of installing the mats at the user’s garden location so that the roots are able to knit essentially unimpeded from the mats into earth below the mats to form the garden, according to the design as per Groups III and IV.

Applicant contends that there can be no anticipation where the cited art is “incapable” of meeting all claim limitations. The Examiner’s conceding of “incapable” is as truthful today as it was when the Examiner first said so.

Other claim elements are not shown in Kawamoto too, as discussed below.

As to claim 21 (Group V.), the cited art also does not mention transporting the corporate logo to a garden site or ...installing the corporate logo at the garden site.... Indeed, there is no mention whatsoever in Kawamoto of a corporate logo. Examiner contends that this claim limitation is readable on Kawamoto’s garden (Final Rejection of 11/14/08, page 9). Applicant contends that the question is not whether an Examiner can read the cited art in one way or another, but instead is whether Kawamoto discloses Applicant’s ...installing the corporate logo at the garden site.... so as to meet the requirements of Sec. 102 for anticipation. The answer is

that the reference does not mention the claim requirement, and thus there is no statutory anticipation. In sum, there is no statutory anticipation of any claim based on Kawamoto because, as to each and every claim, there is at least one claim element required but not shown in Kawamoto.

Please now consider more particular arguments directed to each of the Groups.

**a. Legal Standard**

Anticipation is an exacting standard. Under 35 U.S.C. Sec. 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim. In re Bond, 910 F.2d, 832, 832, 15 USPQ2D 1566, 1567 (Fed. Cir. 1990). Implicitly in a review of an Examiner's anticipation analysis is that the claim must first have been correctly construed to divine the scope and meaning of each contested limitation. See, e.g., In re Paulson, 30 F.3d 1475, 1479, 31 USPQ2D 1671, 1674 (Fed. Cir. 1994)

It is respectfully submitted that, if the claims are properly construed, it will readily be seen that: "the manufactured multiple standardized units of Kawamoto are incapable of knitting with the earth below due to their containment means" as the Examiner truthfully conceded in the first Final Rejection; that statutory anticipation has not been evidenced based on because the cited art is "incapable" of meeting the respective claim limitations; and that Kawamoto has nothing to do with ...installing the corporate logo ....

**b. Claim Construction**

In construing claims, "as an initial matter, the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description

contained in the applicant's specification." In re Morris, 127 F.2d 1048, 1054, 44 USPQ2D 1023, 1027 (Fed. Cir. 1997).

Claim 1 requires ...installing the piece, so that the roots can knit essentially unimpeded from the piece into the earth below the piece at the user's garden location, in accordance with the design.

Claim 2 requires ...installing the mats at the user's garden location so that the roots are able to knit essentially unimpeded from the mats into the earth below the mats to form the garden, according to the design.

These are illustrated in Applicant's Figure 4 in view of Figure 5.

Claim 21 requires ... transporting the corporate logo to a garden site... and ...installing the corporate logo at the garden site....

This is illustrated in Figure 6, especially the originally-filed Figure 6, as shown in the Appendix hereto.

The Board's attention is respectfully drawn to the discussion of these figures for an initial perspective "enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." In re Morris, Id.

**c. Cited Art: Kawamoto**

The Board's attention is respectfully drawn to the figures of Kawamoto for an initial perspective. Note too that Kawamoto states that

"the purpose of this invention... is to offer a garden creating method that can easily create a garden with an overall uniformity and a beautiful view on a rooftop and balcony of a building or inside lot."

(translation at page 3, Para. [0004]. Kawamoto identifies "soil" as part of the problem to be solved by his invention (translation, page 4, line 9) and instead uses "artificial resin" (translation

page 5, lines 11-12). See also, translation at page 5, line 22-24.

In the translation at Para. [0005] Kawamoto teaches “A garden creating method with the characteristic that a water-penetrating type of sheet is first spread in a location where a garden should be created, and multiple standardized garden items are successively arranged side by side over said water-penetrating type of sheet.”

In the translation at Para. [0008] Kawamoto states:

(4) Type illustrated in Figure 17 and 18, in the artificial soil (2b) is filtered inside of a frame part (2a) that forms the shape of a rectangular box, and lawn (2c) is planted over this artificial soil. Stainless steel can be satisfactorily used as the material of the aforementioned frame part (2a), however another metal, resin, china and porcelain, and ceramics, for example can be used besides stainless steel.

In the translation at Para. [0006] Kawamoto states:

“there is a type... that is vertically and horizontally approximately 400 mm long and approximately 120mm high. However, the size and the shape of said garden items are not limited only to these, and any in the size and shape that workers can carry around can be used.”

Drainage holes 25c are mentioned with respect to the particular embodiment at page 1, Para. [0047]. With respect to claim 21, Kawamoto refers to a “garden” in his claim 1, and “lawn” in Para. [0007], “moss fungus” at Para. [0008], and, with respect to the size and shape of the garden items, “any shape that workers can carry around can be used. Para. [0006] Kawamoto states: “the purpose of this invention... is to offer a garden creating method that can easily create a garden with an overall uniformity ....” Para. [0004].

## **B. Separate Arguments for Each Claim Grouping**

### **1. Group I: Kawamoto Does Not Anticipate Claims 1, 18-20**

Independent claim 1 and certain of its dependents 18-20 are grouped together. Claim 1 and all of its dependents require ... installing the piece, so that the roots can knit

essentially unimpeded from the piece into earth below the piece at the user's garden location, in accordance with the design.

First, this claim element is not shown in Kawamoto, and thus there is no anticipation.

As stated above, at page 6 of the Office Action of 03/08/07, the Examiner concedes that "the manufactured multiple standardized units of Kawamoto are incapable of knitting with the earth below due to their containment means." There can be no anticipation because the cited art is incapable of meeting the claim limitation.

Applicant maintains that Kawamoto does not teach all claim elements, and thus statutory anticipation has not been shown. More particularly, Applicant maintains the contentions set forth in the pre-appeal brief review request, e.g., the Examiner concedes that "the manufactured multiple standardized units of Kawamoto are incapable of knitting with the earth below due to their containment means", remains as truthful today as it was when the Examiner conceded it.

Not only would Kawamoto's containment means be incapable, Kawamoto is directed to "a garden on a rooftop and balcony of a building and inside a lot" (translation at page 3, line 32), such that some structure would impede roots from knitting essentially unimpeded from the piece into the earth below the piece .... The same is true for the "water-penetrating sheet", and "artificial resin" (translation page 5, lines 11-12) would also impede roots from knitting essentially unimpeded from the piece into the earth below the piece ....

The Examiner theorizes in the Final Rejection, at page 3:

"the statement that the applicant that the examiner 'concedes' is no longer a valid argument, and the examiner has put forth that the drainage holes (25c) of the Kawamoto '690 piece are capable of allowing roots by way of the drainage holes to find their way to and thus knit essentially unimpeded into the earth below...."

This is an Examiner yarn rather than an anticipatory teaching of Kawamoto. Kawamoto is inadequate as an anticipatory reference. The Board's attention is respectfully drawn back to the above-provided Overview of this Appeal Brief (which is incorporated by reference here for succinctness purposes).

Second, Kawamoto fails to disclose the Applicant's claimed earth below the piece, and instead identifies Kawamoto "soil" as part of the problem to be solved by his invention (translation, page 4, line 9). Kawamoto instead uses "artificial resin" (translation page 5, lines 11-12). See also, translation at page 5, line 22-24.

In the Office Action, at page 7, top paragraph, the Examiner points to Kawamoto (translation paras. 0008 and 0032) as Kawamoto teaching soil, but this mischaracterizes Kawamoto, which instead teaches "artificial soil." The "artificial soil" would itself impede roots from knitting essentially unimpeded with the earth below the piece.

Third, the same is true for the "water-penetrating type of sheet" further impeding the roots finding their way into the earth below the piece despite the Examiner's addition of local color to Kawamoto with what is contended to be "well known to most everyone ever exposed to a plant in a container having drainage holes." Final Rejection at Page 7.

Fourth, Applicant claims steps that must be considered as a whole. Claim 1 requires: ...forming a piece corresponding to a portion of the design... by growing roots in the piece at least one grower location;

transporting the piece to a user's garden location; and

installing the piece, so that...

The Examiner contends that this combination is disclosed in the statement of Kawamoto at Para. [0006] that "the size and the shape of said garden items are not

limited only to these, and any in the size and shape that workers can carry around can be used.” But the size and shape of Kawamoto’s garden items do not teach the combination.

One cannot determine, from Kawamoto, where his piece was formed (i.e., a grower location) or whether Kawamoto involved transporting the piece to a user’s garden location (e.g., size and shape do not indicate actual transporting and even if they did, there is no indication where they are being transported from or what is being transported. Kawamoto does not disclose the claimed combination.

In sum, there is no anticipation because the cited art fails to disclose a least one claimed limitation. Further, cited art incapable of meeting a claim limitation cannot be an anticipation, as conceded by the Examiner, despite his implausible attempt at retrenching. Examiner hypothesizing cannot supplant deficient evidence, and more so, the hypothesizations are explicitly contradicted by Kawamoto’s teachings. The evidence of Kawamoto is insufficient for a Sec. 102 rejection.

With the omission of a claim element in a reference, a prima facie rejection under Sec. 102 is defective. Kawamoto is not an anticipatory reference of claim 1, and thus is not an anticipatory reference of any of the dependent claims, particularly the claims of Group I: 1, 18-20.

## **2. Group II: Kawamoto Does Not Anticipate Claim 17**

Claim 17 is dependent on claim 1. Thus, the arguments above regarding Group I are applicable to Group II, and if the Board determines that the rejection of Group I is in error, then it follows that the rejection of dependent claim 17 is in error. The arguments with respect to Group I are incorporated here by reference.

Claim 17 has been rejected under 102(a) based on Kawamoto (referenced herein to its translation). Claim 17 states wherein the forming the design includes forming a design of a corporate logo. The cited art of Kawamoto says nothing about a corporate logo. Thus, Kawamoto is insufficient to meet the requirements of an anticipatory reference.

The Examiner argues (Final Rejection of 11/14/08 at page 9) that “the garden of Kawamoto encompasses and contemplates a corporate logo garden....” The Examiner also argues (page 9 of the Final Rejection of 11/14/08) that applicant’s specification states that “it is an additional object to provide a system for commercially producing a landscape or garden design, such as a corporate logo” and thus, “Kawamoto anticipates or contemplates a corporate logo garden as claimed, as that form of design is readable on a garden with an overall uniformity and a beautiful view as taught by Kawamoto” (page 9). The Examiner further argues that “rearranging or planning a specific pattern or design such as a logo as broadly claimed is within the scope of the utility and capability of the Kawamoto system” (page 9).

However, applicant’s “object” does not define a design or garden as synonymous with corporate logo, nor does Applicant’s object make Kawamoto an anticipatory disclosure of a corporate logo. Further, it is well established law that a broad disclosure of a genus (the garden of Kawamoto, as suggested by the Examiner) does not render any species (corporate logo, as suggested by the Examiner) that falls within it obvious, let alone anticipated. See, e.g., in In re Baird, 16 F.3d 380 (Fed. Cir. 1994), in which the Federal Circuit held that a species claim is not necessarily obvious in light of a prior disclosure of a genus – and again, the instant rejection is based on *anticipation*. Thus, the Examiner’s reasoning reflects an error of law. There is no teaching or suggestion in Kawamoto to lead the ordinary artisan to select the claimed specie (wherein the forming the design includes forming a design of a corporate logo).



The Examiner contentions at the bottom of page 9 of the Final Rejection of 11/14/08 are unavailing. What is readable by the Examiner is not the same as evidence of statutory anticipation. Further, notice can be taken of the plain and ordinary meaning of the term logo, e.g., Webster's Unabridged Dictionary, which defines a logo as "a graphic representation or symbol of a company name, trademark, abbreviation, etc., often uniquely designed for ready recognition." See also the original Fig. 6 (Appendix) in parent application US Patent No. 6,336,291, consistent with this definition. The Examiner's argument is contradicted by the plain and ordinary meaning of the term logo and the parent's filing, and gives no weight to the preceding word, i.e., corporate logo. See the translation [Para. 0053] where a garden of "overall uniformity" contradicts forming a corporate logo. As to Kawamoto's "a garden on a rooftop and balcony of a building and inside a lot" (translation page 3, line 32), the rejection has offered no reason as to why one would be installing... a corporate logo on a "rooftop and balcony of a building and inside a lot" where it is not publicly viewable.

In sum, regarding the Sec. 102(a) rejection of claim 17, Kawamoto says nothing about a corporate logo. The **only** mention of corporate logo comes from the Applicant. There is no anticipation because Kawamoto fails to disclose at least one claim limitation, and thus the rejection is in error.

### **3. Group III: Kawamoto Does Not Anticipate Claims 2-15**

Independent claim 2 and certain of its dependents 3-15 are grouped together. Claim 2 and its dependents 3-15 require ...installing the mats at the user's garden location so that the roots are able to knit essentially unimpeded from the mats into the earth below the mats to form the garden, according to the design.

First, this claim element is not shown in Kawamoto, and thus there is no anticipation.

As stated above with respect to the Sec. 102 rejection of claim 1 and certain of its dependents, at page 6 of the Office Action of 03/08/07, the Examiner concedes that “the manufactured multiple standardized units of Kawamoto are incapable of knitting with the earth below due to their containment means.” There can be no anticipation because the cited art is incapable of meeting the claim limitation.

Applicant maintains that Kawamoto does not teach all claim elements, and thus statutory anticipation has not been shown. More particularly, Applicant maintains the contentions set forth in the pre-appeal brief review request, e.g., the Examiners concedes that “the manufactured multiple standardized units of Kawamoto are incapable of knitting with the earth below due to their containment means”, which remains as truthful today as it was when the Examiner said it.

There can be no anticipation where the cited art is incapable of meeting claim limitations, and the Examiner has not made out a case of prima facie anticipation for these claims.

Not only would Kawamoto’s containment means be incapable, Kawamoto is directed to “a garden on a rooftop and balcony of a building and inside a lot” (translation at page 3, line 32), such that some structure would impede roots from knitting **essentially unimpeded from the mats into the earth** below the mats into the earth below the mats to form a garden **according to the design**. The same is true for the “water-penetrating sheet”, and “artificial resin” (translation page 5, lines 11-12) would also impede roots from knitting **essentially unimpeded from the mats into the earth below the mats... according to the design**

The Examiner theorizes in the Final Rejection of 11/14/08, at page 3:

“the statement that the applicant that the examiner ‘concedes’ is no longer a valid argument, and the examiner has put forth that the drainage holes (25c) of the Kawamoto ‘690 piece are capable of allowing roots by way of the drainage

holes to find their way to and thus knit essentially unimpeded into the earth below....”

This is an Examiner yarn rather than a teaching of Kawamoto. Kawamoto is inadequate as an anticipatory reference. (The Board’s attention is respectfully drawn back to the above-provided Overview of this Appeal Brief, incorporated here by reference with the caveat that claim 1 and claim 2 have distinct limitations.)

Second, Kawamoto fails to disclose the Applicant’s claimed earth below the mats, and instead identifies Kawamoto “soil” as part of the problem to be solved by his invention (translation, page 4, line 9). Kawamoto instead uses “artificial resin” (translation page 5, lines 11-12). See also, translation at page 5, line 22-24.

In the Office Action, at page 7, top paragraph, the Examiner points to Kawamoto (translation paras. 0008 and 0032) as Kawamoto teaching soil, but this mischaracterizes Kawamoto, which instead teaches “artificial soil.” The “artificial soil” would itself impede roots from knitting essentially unimpeded with the earth below the mats...

Third, the same is true for the “water-penetrating type of sheet” further impeding the roots finding their way into the earth below the mats... despite the Examiner’s addition of local color to Kawamoto with what is contended to be “well known to most everyone ever exposed to a plant in a container having drainage holes.” Final Rejection at Page 7.

Fourth, Kawamoto fails to disclose harvesting the mats in accordance with the claim as a whole. The Final Rejection of 11/14/08 makes no contention as to this claim element, presumably because it is not disclosed in the cited reference.

Fifth, Applicant claims steps that must be considered as a whole. Claim 1 requires:  
...forming pieces corresponding to portions of the design by mats of roots of  
respectively different plants... at least one grower location;

harvesting the mats:

transporting the mats to a user's garden location; and

installing the mats so that...

The Examiner contends that this combination is disclosed in the statement of Kawamoto at Para. [0006] that "the size and the shape of said garden items are not limited only to these, and any in the size and shape that workers can carry around can be used." But the size and shape of Kawamoto's garden items do not teach the combination.

One cannot determine, from Kawamoto, where his "mats" were formed (i.e., a grower location) or whether Kawamoto involved harvesting or whether Kawamoto involved transporting the mats to a user's garden location (e.g., size and shape do not indicate actual transporting and even if they did, there is no indication where they are being transported from) or what was transported. There is no mention in Kawamoto of harvesting the mats, and Kawamoto does not disclose the claimed combination.

In sum, there is no anticipation because Kawamoto fails to disclose a least one the claimed limitation. Cited art incapable of meeting a claim limitation cannot be an anticipation, as conceded by the Examiner, despite his implausible attempt at retrenching. Examiner hypothesizing cannot supplant deficient evidence, and more so, the hypothecations are explicitly contradicted by Kawamoto's teachings. The evidence is insufficient for a Sec. 102 rejection.

The omission of a claim element in a reference renders a prima facie rejection under Sec. 102 defective. Kawamoto is not an anticipatory reference of claim 2, and thus is not an anticipatory reference of the dependent claims 3-15.

**4. Group IV: Kawamoto Does Not Anticipate Claim 17**

Claim 17 is dependent on claim 1. Thus, the arguments above regarding Group III are applicable to Group IV, and if the Board determines that the rejection of Group III is in error, then it follows that the rejection of dependent claim 17 is in error. The arguments with respect to Group III are incorporated here by reference.

Claim has been rejected under 102(a) based on Kawamoto (referenced herein to its translation). Claim 16 states wherein the forming the design includes forming a design of a corporate logo. The cited art of Kawamoto says nothing about a corporate logo. Thus, Kawamoto is insufficient to meet the requirements of an anticipatory reference.

The Examiner argues (Final Rejection of 11/14/08 at page 9) that “the garden of Kawamoto encompasses and contemplates a corporate logo garden....” The Examiner also argues (page 9 of the Final Rejection of 11/14/08) that applicant’s specification states that “it is an additional object to provide a system for commercially producing a landscape or garden design, such as a corporate logo” and thus, “Kawamoto anticipates or contemplates a corporate logo garden as claimed, as that form of design is readable on a garden with an overall uniformity and a beautiful view as taught by Kawamoto” (page 9). The Examiner further argues that “rearranging or planning a specific pattern or design such as a logo as broadly claimed is within the scope of the utility and capability of the Kawamoto system” (page 9).

However, applicant’s “object” does not define a design or garden as synonymous with corporate logo, nor does Applicant’s object make Kawamoto an anticipatory disclosure of a corporate logo. Further, it is well established law that a broad disclosure of a genus (the garden of Kawamoto, as suggested by the Examiner) does not render any species (corporate logo) that falls within it obvious, let alone anticipated. See, e.g., in In re Baird, 16 F.3d 380

(Fed. Cir. 1994), in which the Federal Circuit held that a species claim is not necessarily obvious in light of a prior disclosure of a genus – and again, the instant rejection is based on *anticipation*. Thus, the Examiner's reasoning reflects an error of law. There is no teaching or suggestion in Kawamoto to lead the ordinary artisan to select the claimed specie (wherein the forming the design includes forming a design of a corporate logo).

The Examiner contentions at the bottom of page 9 of the Final Rejection of 11/14/08 are unavailing. What is readable by the Examiner is not the same as sufficient evidence of statutory anticipation, and notice can be taken of the plain and ordinary meaning of the term logo, e.g., Webster's Unabridged Dictionary, which defines a logo as "a graphic representation or symbol of a company name, trademark, abbreviation, etc., often uniquely designed for ready recognition." See also the original Fig. 6 (Appendix) in parent application US Patent No. 6,336,291, consistent with this definition. The Examiner's argument is contradicted by the plain and ordinary meaning of the term logo and the parent's filing, and gives no weight to the preceding word, i.e., corporate logo. See the translation [Para. 0053] where a garden of "overall uniformity" contradicts forming a corporate logo. As to Kawamoto's "a garden on a rooftop and balcony of a building and inside a lot" (translation page 3, line 32), the rejection has offered no reason as to why one would be installing... a corporate logo on a "rooftop and balcony of a building and inside a lot" where it is not publicly viewable.

In sum, regarding the Sec. 102(a) rejection of claim 16, Kawamoto says nothing about a corporate logo. The **only** mention of corporate logo comes from the Applicant. There is no anticipation because Kawamoto fails to disclose at least one claim limitation, and the rejection is in error.

**5. Group V: Kawamoto Does Not Anticipate Claim 21**

Claim 21 has been rejected under 102(a) based on Kawamoto (referenced herein to its translation). Every step in the claim requires a corporate logo, e.g., transporting the corporate logo to a garden site, etc. The cited art of Kawamoto says nothing about a corporate logo.

With regard to the Sec. 102 rejection, in the Final Rejection of 11/14/08 at page 9, the Examiner points to the rejection of claims 1, 2, 16, and 17. But Kawamoto does not mention transporting the corporate logo to a garden site, and nothing in Kawamoto even mentions a corporate logo. Thus, the evidence is not sufficient for statutory anticipation.

The Examiner argues (Final Rejection of 11/14/08 at page 9) that “the garden of Kawamoto encompasses and contemplates a corporate logo garden...” The Examiner also argues (page 9 of the Final Rejection of 11/14/08) that applicant’s specification states that “it is an additional object to provide a system for commercially producing a landscape or garden design, such as a corporate logo” and thus, “Kawamoto anticipates or contemplates a corporate logo garden as claimed, as that form of design is readable on a garden with an overall uniformity and a beautiful view as taught by Kawamoto” (page 9). The Examiner further argues that “rearranging or planning a specific pattern or design such as a logo as broadly claimed is within the scope of the utility and capability of the Kawamoto system” (page 9).

However, applicant’s “object” does not define a design or garden as synonymous with corporate logo, nor does Applicant’s object make Kawamoto an anticipatory disclosure of a corporate logo. Further, it is well established law that a broad disclosure of a genus (the design of Kawamoto, as suggested by the Examiner) does not render any species (corporate logo, as suggested by the Examiner) that falls within it obvious, let alone anticipated. See, e.g., in In re Baird, 16 F.3d 380 (Fed. Cir. 1994), in which the Federal Circuit held that a species claim is not

necessarily obvious in light of a prior disclosure of a genus. In the present case, the rejection is based on *anticipation*, and so the Examiner's reasoning is an error of law. There is no teaching or suggestion in Kawamoto to lead the ordinary artisan to select the claimed specie (transporting the corporate logo to a garden site).

The Examiner contentions at the bottom of page 9 of the Final Rejection of 11/14/08 are unavailing. What is readable by the Examiner is not the same as sufficient evidence of statutory anticipation, and notice can be taken of the plain and ordinary meaning of the term logo, e.g., Webster's Unabridged Dictionary, which defines a logo as "a graphic representation or symbol of a company name, trademark, abbreviation, etc., often uniquely designed for ready recognition." See also the original Fig. 6 (Appendix) in parent application US Patent No. 6,336,291, consistent with this definition. The Examiner's argument is contradicted by the plain and ordinary meaning of the term logo and the parent's filing, and gives no weight to the preceding word, i.e., corporate logo. See the translation [Para. 0053] where a garden of "overall uniformity" contradicts or teaches away from forming a corporate logo. As to Kawamoto's "a garden on a rooftop and balcony of a building and inside a lot" (translation page 3, line 32), and the rejection has offered no reason as to why one would be transporting the corporate logo to a "rooftop and balcony of a building and inside a lot" where it is not publicly viewable.

In sum, regarding the Sec. 102(a) rejection, every step in the claim requires a corporate logo, e.g., transporting the corporate logo to a garden site, etc. Kawamoto says nothing about a corporate logo. The **only** mention of corporate logo, e.g., the claim step of transporting the corporate logo to a garden site, etc, comes from the Applicant. There is no anticipation because the cited art fails to disclose any of the claimed steps because there is no mention in



Kawamoto of a corporate logo. This omission of one or more essential element needed for a prima facie rejection is a clear error in the rejection.

**6. Group VI: Kawamoto Does Not Anticipate Claim 22**

The argument with respect to the independent claim 1 is incorporated by reference here. Further, there is no teaching in Kawamoto of the biodegradable matrix within the piece.

**7. Group VII: Kawamoto Does Not Anticipate Claim 23**

The argument with respect to the independent claim 1 is incorporated by reference here. Further, there is no teaching in Kawamoto of the biodegradable matrix within the piece.

**8. Group VIII: Kawamoto Does Not Anticipate Claim 24**

The argument with respect to the independent claim 1 is incorporated by reference here. Further, there is no teaching in Kawamoto of the growing the corporate logo in a biodegradable matrix.

**VIII. Conclusion**

With respect to claims of each Group, at least one claim element is not shown in Kawamoto. Thus, for the reasons more fully set out above, have not been properly shown as anticipated under Sec. 102(a), and the rejection should be reversed. Allowance is respectfully requested.

Respectfully submitted,



Date: June 8, 2009

\_\_\_\_\_  
Peter K. Trzyna  
(Reg. No. 32,601)

P.O. Box 7131  
Chicago, IL 60680-7131  
(312) 240-0824

Atty. Reference: Skuba-P1-03  
Ser. No. 10/730,325  
Art Unit 3644

**VIII. Claims Appendix**

1. A method of forming a garden, the method including:

forming a design for a garden;

implementing the design by forming a piece corresponding to a portion of the design, the piece including at least one member of the group consisting of forbs, a shrub, a tree, annuals, flowering plants, a bush, wildflowers, grasses, a space for a shrub, a space for a tree, a space for annuals, a space for layers of flowering plants, a space for a bush, a space for wildflowers, a space for grasses, a space for a walkway, and a space for a garden accouterment, by growing roots in the piece at at least one grower location;

transporting the piece to a user's garden location; and

installing the piece, so that the roots can knit essentially unimpeded from the piece into earth below the piece at the user's garden location, in accordance with the design.

2. A method of forming a garden, the method including:

forming a design for a garden;

forming pieces corresponding to portions of the design by growing mats of roots of respectively different kinds of plants, in accordance with the design, at at least one grower location;

harvesting the mats;

transporting the mats to a user's garden location; and

installing the mats at the user's garden location so that the roots are able to knit essentially unimpeded from the mats into earth below the mats to form the garden, according to the design.

3. The method of claim 2, wherein the design is implemented with at least one of the pieces including at least one member of the group consisting of forbs, a shrub, a tree, annuals, flowering plants, a bush, wildflowers, grasses, a crop, a space for a shrub, a space for a tree, a space for annuals, a space for flowering plants, a space for a bush, a space for wildflowers, a space for grasses, a space for a walkway, and a space for a garden accouterment, in accordance with the design.

4. The method of claim 3, further including a second member of the group, in accordance with the design.

5. The method of claim 3, further including a third member of the group, in accordance with the design.

6. The method of claim 3, wherein the mats differ by at least one kind of plant that is a member of the group, in accordance with the design.

7. The method of claim 3, wherein the mats differ by at least two kinds of plants that are members of the group, in accordance with the design.

8. The method of claim 3, wherein the mats differ by at least three kinds of plants that are members of the group, in accordance with the design.

9. The method of claim 3, wherein the mats differ by at least four kinds of plants that are members of the group, in accordance with the design.

10. The method of claim 3, wherein the mats differ by at least five kinds of plants that are members of the group, in accordance with the design.

11. The method of claim 3, wherein the mats differ by at least six kinds of plants that are members of the group, in accordance with the design.

12. The method of claim 3, wherein the mats differ by at least seven kinds of plants that are members of the group, in accordance with the design.

13. The method of claim 3, wherein the mats differ by at least eight kinds of plants that are members of the group, in accordance with the design.

14. The method of claim 6, further including lawn on a portion of at least one of the mats.

15. The method of claim 7, further including lawn on a portion of at least one of the mats.

16. The method of claim 2, wherein the forming the design includes forming a design of a corporate logo.

17. The method of claim 1, wherein the forming the design includes forming a design of a corporate logo.

18. The method of claim 1, wherein the forming the piece is carried out so as to include a second member of the group, in accordance with the design.

19. The method of claim 1, wherein the forming the piece is carried out so as to include a third member of the group, in accordance with the design.

20. The method of claim 1, further including forming a second piece corresponding to a second portion of the design, the second piece differing from the first piece by at least one kind of plant that is a member of the group, in accordance with the design;  
growing the second piece, in accordance with the design;  
transporting the second piece to the user's garden location; and  
installing the second piece at the user's garden location, in accordance with the design.

21. A method of forming a corporate logo garden, the method including:  
forming a design for a garden comprised of a corporate logo;  
growing the corporate logo, in accordance with the design, including at least one member of the group consisting of a forb, a shrub, a tree, an annual, a flowering plant, a bush, a wildflower, and grass, at a grower location;

transporting the corporate logo to a garden site; and  
installing the corporate logo at the garden site to produce the garden having the corporate logo design.

22. The method of claim 1, wherein the forming comprises locating a biodegradable matrix within the piece.

23. The method of claim 2, wherein the growing comprises locating a biodegradable matrix within the piece.

24. The method of claim 3, wherein the growing comprises growing the corporate logo in a biodegradable matrix.

**IX. Evidence Appendix**

No evidence.



**X. Related Proceedings Appendix**

There are no related proceedings.